

REMARKS

In response to the Office Action mailed August 31, 2007, Applicant respectfully requests reconsideration. To further prosecution of this application, amendments have been made in the claims, and each of the rejections set forth in the Office Action has been carefully considered and is addressed below. The claims as presented are believed to be in condition for allowance.

Claims 1-195 were previously pending in this application. Claims 1-113 and 126-195 were previously withdrawn, and are cancelled herein. Claims 114, 116-121 and 124 are amended. Claims 196-219 are added. As a result, claims 114-125 and 196-219 are pending for examination, with claims 114, 212, 213 and 214 being independent. No new matter has been added.

Claim Objections

The Office Action objects to claims 118-120 and 124 for purported informalities. These objections are addressed in turn below.

The Office Action contends that the limitation “enabling the delivery of information” recited by each of claims 118 and 120 should be replaced with “enabling the delivery of the information.” Claims 118 and 120 have been so amended.

The Office Action also contends that the limitation “once that consent is deemed given by the user” recited by each of claims 118 and 120 should be replaced with “once the consent is deemed given by the user.” As the limitation referenced by the Office Action is not recited by claims 118 and 120, but rather by claim 114, claim 114 is amended herein as the Office Action suggests.

The Office Action contends that claim 119 is of improper dependent form, as claim 119 recites a system, but depends from claim 118, which recites a method. Claim 119 is amended to also recite a method.

The Office Action contends that claim 124, which is a multiple dependent claim, is in

improper form. Specifically, the Office Action contends that a multiple dependent claim should refer to the claims from which it depends in the alternative. The Office Action suggests that the limitation “the method of any of claims 114-123” be changed to “the method of any one of claims 114-123.” Claim 124 has been so amended.

In view of the foregoing, Applicant respectfully requests withdrawal of the objections to claims 118-120 and 124.

Claim Rejections Under 35 U.S.C. §112

Claims 114-115 and 119 are rejected under 35 U.S.C. §112, second paragraph, for purportedly being indefinite. These rejections are addressed in turn.

The Office Action contends that the meaning of claim 115 is unclear in light of claim 114, from which claim 115 depends. Claim 114 recites enabling delivery of information to a user once consent is deemed given by the user, and claim 115 recites receiving the consent. The Office Action questions how consent could be deemed given by the user unless it has been received.

Applicant respectfully points out that deeming a user’s consent to have been given does not require receiving the user’s consent, as there are numerous potential bases for deeming consent to have been given. For example, consent may be deemed given if the user does not respond to a message requesting such consent within a specified timeframe, such as a timeframe specified within the message.

In view of the foregoing, the meaning of claim 115 is not unclear in light of claim 114, as the Office Action contends. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 114-115 under 35 U.S.C. §112, second paragraph.

The Office Action contends that insufficient antecedent basis exists for the limitation “in electronic form” recited by claim 119. Claim 119 is amended herein to remove this limitation, rendering the rejection moot.

Claim Rejections Under 35 U.S.C. §101

Claims 114-125 are rejected under 35 U.S.C. §101 for purportedly being directed to non-statutory subject matter. Specifically, the Office Action contends that the invention recited by independent claim 114 fails to satisfy the “useful” and “concrete” prongs of the requirement that inventions produce a “useful, concrete and tangible” result. Applicant respectfully traverses this rejection.

The Office Action contends that independent claim 114 does not produce a “useful” result because Applicant has not disclosed enough information about the invention to make its usefulness apparent. The Office Action cites MPEP §2107.01, which states that deficiencies under the “useful invention” requirement of 35 U.S.C. §101 may arise when the Applicant “fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention.” This contention is contravened by Applicant’s specification, which sets forth a substantial amount of information regarding the claimed invention to make its usefulness immediately apparent to those skilled in the art.

Numerous passages in Applicant’s specification make clear to those skilled in the art that requesting consent of a user to electronic delivery of information, and once the consent is deemed given, enabling the delivery of the information to the user has significant utility. For example, Applicant’s specification explains that the Securities and Exchange Commission (SEC) requires that securities issuers make certain information on issued securities available to prospective and existing investors (p. 1, lines 11-13). For example, an issuer of a mutual fund must make a fund prospectus available to prospective and existing investors in the fund (p. 1, lines 13-16). Delivering a paper prospectus (and/or other SEC-mandated documents) to each prospective and existing investor is time-consuming and costly for securities issuers, as printing and mailing costs alone can amount to millions of dollars per year for a single security (p. 1, lines 18-22). Accordingly, embodiments of the invention provide a system and apparatus which allow information to be delivered electronically to a user (e.g., an investor) once the user consents to electronic delivery (p. 3, lines 3-7). For example, a securities issuer may request a

user's consent to electronic delivery of information, and once consent is deemed given, an indication of consent having been given may be stored (p. 3, lines 7-10). Depending on the nature of the consent that was requested and given, information may be sent to the user in electronic form (e.g., e-mailed), the user may be sent a notification that information is available for access (e.g., via download, such as from an FTP site), or electronic delivery of information to the user may be otherwise enabled (p. 3, lines 12-17; p. 4, lines 18-21).

In setting forth general principles governing utility rejections, the MPEP instructs, "[i]f the applicant has asserted that the claimed invention is useful for any particular practical purpose (i.e., that it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility." MPEP §2107(II)(B)(1). A "specific" utility is one which is specific to the subject matter claimed and can "provide a well-defined and particular benefit to the public." MPEP §2107.01(I)(A). To satisfy the "substantial" utility requirement, the claimed invention must have a significant and presently available benefit to the public. MPEP §2107.01(I)(B). As the preceding summary makes clear, the claimed invention may result in the user's consenting to electronic delivery of information, and enabling the electronic delivery of the information to the user to occur, thus allowing securities issuers to save the amounts otherwise spent on printing and mailing the information to the user. The benefit produced by the claimed invention is well-defined and particular (thus satisfying the "specific utility" requirement) as well as significant and publicly available (thus satisfying the "substantial utility" requirement). The result produced by each of claims 114-125 is thus "useful."

The Office Action also contends that independent claim 114 fails to produce a "concrete" result. Specifically, the Office Action contends that the claim term "enabling" is abstract and broadly refers to providing the means, opportunity or knowledge to do something, and thus does not actually require that something be done. The Office Action thus concludes that the claim does not produce a concrete result.

Applicant respectfully points out that whether or not a claim is "abstract" or "broadly

refers” to a concept is not the correct test for determining whether the claim produces a “concrete” result. In this respect, MPEP §2106(IV)(C)(2)(2)(c) provides that the question of whether an invention produces a concrete result “usually arises when a result cannot be assured. In other words, a process must have a result that can be substantially repeatable or the process must substantially produce the same result again.”

The result produced by the method of claim 114 is repeatable, and thus concrete. Applicant’s specification describes automated techniques for requesting a user’s consent to electronic delivery of information, and enabling the delivery of the information once the user’s consent is deemed given. As a result, claims 114-125 produce a “concrete” result.

In view of the foregoing, each of claims 114-125 produces a “useful” and “concrete” result, such that these two prongs of the requirement that inventions produce a “useful, concrete and tangible” result are satisfied. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 114-125 under 35 U.S.C. § 101 for purportedly being directed to non-statutory subject matter.

Claim Rejections Under 35 U.S.C. §102

Independent claim 114 is rejected under 35 U.S.C. § 102(b) as purportedly being anticipated by U.S. Patent No. 6,192,407 to Smith (“Smith”). Claim 114 is amended herein, and patentably distinguishes over Smith.

Claim 114 is directed to a method wherein before access to information is provided, a user’s consent to electronic delivery of the information is requested. Once consent is deemed given by the user, delivery of the information to the user is enabled.

Smith fails to satisfy all of the limitations recited by amended claim 114, as Smith fails to disclose or suggest requesting consent of a user to electronic delivery of information *before providing access to the information*.

Smith discloses an architecture for to distributing information to each of a number of

recipients via a private uniform resource locator (URL) (Abstract). Each private URL uniquely identifies an intended recipient, a document or set of documents to be delivered, and other parameters (Abstract). With reference to FIG. 20, Smith discloses a document delivery system which uses the private URLs (col. 15, lines 28-30). In the system of FIG. 20, a sender 300 forwards a document 310 to a server 315, which stores the document and generates a private URL for each intended recipient (col. 15, lines 30-33). The server encodes information relating to the user, document, delivery and transaction identifiers within the private URL (col. 15, lines 33-37). Each private URL is then forwarded to an intended recipient by email, so that the recipient is notified that a document has been sent to him/her (col. 15, lines 37-40). Using the private URL, the recipient accesses the document (col. 15, lines 40-41). Thus, in the system of Smith, a recipient is provided access to a document at the same time that the recipient's consent to send the document electronically is requested.

By contrast, the method of claim 114 requires requesting consent of a user to electronic delivery of information before providing access to the information. As the system of Smith simultaneously provides access to information and requests the user's consent to electronically deliver the information, Smith fails to satisfy this limitation of claim 114.

Accordingly, claim 114 patentably distinguishes over Smith, such that the rejection of claim 114, and the claims that depend therefrom, under 35 U.S.C. §102(b) as purportedly being anticipated by Smith should be withdrawn.

Double Patenting Rejections

Claims 114-125 are rejected under the doctrine of obviousness-type double patenting as purportedly being unpatentable over claims 1-24 of commonly assigned U.S. Patent No. 6,702,506 ("the '506 patent"). The Office Action contends that although claims 114-125 are not identical to claims 1-24 of the '506 patent, they are not patentably distinct.

Without acceding to the propriety of this rejection, Applicant files herewith a Terminal

Disclaimer to disclaim the terminal part of the statutory term of any patent granted on this application which would extend beyond the expiration date of the full statutory term of the '506 patent. Accordingly, Applicant respectfully requests that the obviousness-type double patenting rejection of claims 114-125 over claims 1-24 of the '506 patent be withdrawn.

Claims 114-115 are also rejected under the doctrine of obviousness-type double patenting as purportedly being unpatentable over claims 1-61 of U.S. Patent No. 7,028,190 ("the '190 patent"). The Office Action contends that although claims 114-115 are not identical to claims 1-61 of the '190 patent, they are not patentably distinct.

Without acceding to the propriety of this rejection, Applicant files herewith a terminal disclaimer to disclaim the terminal part of the statutory term of any patent granted on this application which would extend beyond the expiration date of the full statutory term of the '190 patent. Accordingly, Applicant respectfully requests that the obviousness-type double patenting rejection of claims 114-115 over claims 1-61 of the '190 patent be withdrawn.

New Claims 212-219

Claims 212-219 are provided to further define Applicant's contribution to the art.

Independent claim 212 is directed to a method wherein before access to information is provided, consent of a user to electronic delivery of the information is requested. If consent is deemed given by the user, delivery of the information to the user is enabled.

As discussed above with reference to claim 114, the prior art of record fails to disclose or suggest requesting consent of a user to electronic delivery of information before providing access to the information, as required by claim 212. As a result, claim 212 patentably distinguishes over the prior art of record.

Independent claim 213 is directed to a method comprising providing a user electronic access to information and enabling the user to negatively consent to the electronic access to the information. Claim 213 patentably distinguishes over the prior art of record, as none of the cited references says

anything at all about enabling a user to negatively consent to electronic access to information. For example, Smith says nothing about enabling a user to negatively consent to electronic access to information.

Independent claim 214 is directed to a method comprising providing a link to enable a user to electronically access information, and enabling the user to request an alternative version of the information. As with claim 213, the prior art of record fails to satisfy all of the limitations of claim 214. For example, Smith says nothing at all about enabling a user to request an alternative version of information. As a result, claim 214, and the claims that depend therefrom, patentably distinguish over the prior art of record.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

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Respectfully submitted,

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